

### REMARKS

Claims 1-61 are pending in the present application. By this Response, claims 1, 2, 15, 16, 29, 34, 35, 48 and 49 are amended. Claims 1, 7, 15, 21, 34, 40, 48 and 54 are amended to incorporate subject matter similar to claims 2, 16, 35 and 49. Claim 29 is amended to correct minor informalities. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

Amendments are made to the specification to correct errors and to clarify the specification. No new matter is added by any of the amendments to the specification.

**I. 35 U.S.C. § 102, Alleged Anticipation, Claims 1-10, 12-32 and 34-61**

The Office Action rejects claims 1-10, 12-32 and 34-61 under 35 U.S.C. § 102(b) as being allegedly anticipated by May et al. (U.S. Patent No. 5,809,251). This rejection is respectfully traversed.

As to claim 29, the Office Action states:

As per claim 29, May discloses a network; a server connected to the network; a client computer connected to the network; and at least one target computer connected to the network (col. 1 lines 64-65, "an MIS has been used effectively to manage PCs and servers interconnected by a ... network"), wherein each of the at least one target computer executes a software installation agent, (col. 1, lines 15-16, "a desktop management interface (which contains agent(s) is) located within each PC"), wherein the client computer submits a request to the server, responsive to receiving the request the server schedules an appropriate time to install an item of software (col. 1 lines 34-35, "(client computers send requests to servers)", and col. 2 lines 8-9, "(the server schedules) remote installation of ... software ... into a remote computer"), at the appropriate time the server notifies the software installation agent on each of the at least one target computer that the item of software is to be installed, the software agent on each of the at least one target computer collects data about the at least one target computer to make a determination if and how the item of software can be installed and configured (col. 2 lines 15-18, "(at the appropriate time), the management information system (uses agents to collect data about the target computer to determine what software should be installed)"), based on the determination the software installation agent on each of the at least one target computer downloads, installs, and

**configures the item of software on each of the at least one target computer (Col. 2 lines 8-10, "(based on the analysis of the collected data), remote installation of ... software is (downloaded, installed, and configured on a target computer)").**

Office Action dated March 25, 2004, pages 5-6.

Claim 29 reads as follows:

29. A system for automatically installing software, comprising:  
a network;  
a server connected to the network;  
a client computer connected to the network; and  
at least one target computer connected to the network, wherein each of the at least one target computer executes a software installation agent, wherein the client computer submits a request to the server, responsive to receiving the request the server schedules an appropriate time to install an item of software, at the appropriate time the server notifies the software installation agent on each of the at least one target computer that the item of software is to be installed, the software agent on each of the at least one target computer collects data about the at least one target computer to make a determination if and how the item of software can be installed and configured, based on the determination the software installation agent on each of the at least one target computer downloads, installs, and configures the item of software on each of the at least one target computer.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that May does not identically show each and every feature of the claims arranged as they are in the claims. Specifically, May does not teach where the client computer submits a request to the server and collecting data about the at least one target computer to make a determination if and how the item of software can be installed and configured.

May is directed to remote installation of an update of software is forwarded by a management information system into a remote computer. The management information system requests from the remote computer the current version information about the software within the remote computer. When the management information system determines the current version of the software within the remote computer needs to be updated, the update of the software is downloaded from the management information system to the remote computer.

Thus, in the system of May, the management information system requests the current version information about the software already installed within the remote computer and only updates of already installed software are remotely installed by the management information system. Nowhere, in any section of May, is it taught that the client computer submit a request to the server to install an item of software on the client computer system. The Office Action alleges that this feature is taught at column 1, lines 34-35 and column 2, lines 8-9, which read as follows:

Within the DMI, a service layer is a program, running on the local machine or personal computer, that collects information from elements, manages that information in the MTF database, and passes the information to management applications as requested.

(Column 1, lines 31-35)

In accordance with the preferred embodiment of the present invention, remote installation of an update of software is forwarded by a management information system into a remote computer.

(Column 2, lines 7-10)

In column 1, lines 31-35, May is merely describing that the Desktop Management Interface (DMI) collects information about the elements on the remote computer at the request of the management information system. May clearly teaches the management information system requests from the remote computer the current version information about the software within the remote computer (see column 2, lines 14-17). In response to the request, the DMI collects information about the elements on the remote computer and sends it to the management information system. In response to the collected information, the management information system determines the version of the software on the remote computer and if the version needs to be updated the management

information system downloads the software update, as described in column 2, lines 7-10. Thus, May teaches that the management information system requests version information from the remote computer and updates the version of already existing software. In contradistinction, the presently claimed invention states the client computer submit a request to the server to install an item of software on the client computer system.

Furthermore, May does not teach collecting data about the target computer to make a determination if and how the item of software can be installed and configured. The Office Action alleges that this feature is taught at column 2, lines 15-18, which reads as follows:

The management information system requests from the remote computer the current version information about the software within the remote computer.

(Column 2, lines 15-18)

In this section, May is merely describing that the management information system request the current version information about the software within the remote computer. May is not concerned with whether the software can be installed and configured on a client computer, as a version of the software is already running on the remote computer. Thus, no determination as to whether the software can be installed and configured is performed by the system of May.

Independent claims 1, 7, 15, 21, 34, 40, 48 and 54 recite similar features in their respective claim terminology. Claims 1, 15, 34 and 48 recite “receiving an instruction from a client computer to install an item of software on the computer system; collecting data about the computer system to form collected data; based on the collected data, determining whether the item of software can be installed on and executed by the computer system; if the item of software can be installed on and executed by the computer system, based on the collected data, downloading a proper version of the item of software from a server; installing the proper version; and based on the collected data, setting configuration options associated with the proper version.” Claims 7, 21, 40 and 54 recite “receiving an instruction from a user input at a client computer to install an item of software on the at least one computer system; determining whether the item of software can be installed on and executed by the computer system; if the item of software

can be installed on and executed by the computer system, directing at least one software installation agent executing on the at least one computer system to download, install, and configure the item of software on the at least one computer system."

Thus, May does not teach each and every feature of independent claims 1, 7, 15, 21, 29, 34, 40 and 54 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 7, 15, 21, 29, 34, 40 and 54, respectively, the specific features of dependent claims 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61 are not taught by May. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-10, 12-15, 17-32, 34, 36-48 and 50-61 under 35 U.S.C. § 102.

Furthermore, May does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement May such that the client computer submits a request to install software to the server and collect data about the at least one target computer to make a determination if and how the item of software can be installed and configured, one of ordinary skill in the art would not be led to modify May to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify May in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

Moreover, in addition to their dependency from independent claims 1, 7, 15, 21, 29, 34, 40 and 54, the specific features recited in dependent claims 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61 are not taught by May. For example, with regard to claims 4, 18, 37 and 51, May does not teach analyzing the collected data to determine the proper version and the configuration options. The Office Action alleges that this feature is taught at column 2, lines 18-20, which reads as follows:

When the management information system determines the current version of the software within the remote computer needs to be updated, the management information system determines whether the alternate communication path is adequate for downloading the update of the software.

(Column 2, lines 18-23)

In this section, May is describing the management information system determining the version of software residing on the remote computer based on the collected data sent by the DMI. However, this function is performed by the management information system on the server and not on the client computer. Though this portion of May may teach the function as performed on a server as in claim 3, it does not teach this feature as performed by the client computer as in claims 4, 18, 37 and 51.

As a further example, with regard to claims 25, 44 and 58, the Office Action alleges that May discloses such claimed limitations as addressed in claims 2-14. Claims 25, 44 and 58 recite features similar to claim 11, which is not rejected in this 102 rejection but in a 103 rejection. Thus, May does not disclose the features of dependent claims 25, 44 and 58.

Therefore, in addition to being dependent on independent claims 1, 7, 15, 21, 29, 34, 40 and 54, respectively, dependent claims 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61 are also distinguishable over May by virtue of the specific features recited in these claims. Accordingly, Applicants respectfully request withdrawal of the rejection of 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61 under 35 U.S.C. § 102.

## **II. 35 U.S.C. § 103, Alleged Obviousness, Claims 11 and 33**

The Office Action rejects claims 11 and 33 under 35 U.S.C. § 103(a) as being allegedly unpatentable over May et al. (U.S. Patent No. 5,809,251) in view of applicants admitted prior art (AAPA). This rejection is respectfully traversed.

Claims 11 and 33 are dependent on independent claims 7 and 29 and, thus, these claims distinguish over May for at least the reasons noted above with regards to claims 7 and 29. Moreover, AAPA does not provide for the deficiencies of May and, thus, any alleged combination of May and AAPA would not be sufficient to reject independent claims 7 and 29 or claims 11 and 33 by virtue of their dependency. That is, AAPA does not teach where the client computer submits a request to the server and collecting data about the at least one target computer to make a determination if and how the item of software can be installed and configured.

Moreover, the Office Action may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, May and AAPA cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

In view of the above, May and AAPA, taken either alone or in combination, fail to teach or suggest the specific features recited in independent claims 7 and 29, from which claims 11 and 33 depend. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 11 and 33 under 35 U.S.C. § 103.

### III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: June 21, 2004



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